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# Seng Kong Shutter Industries Sdn Bhd & Anor v SKB Shutters Manufacturing Sdn Bhd

COURT OF APPEAL (PUTRAJAYA) — CIVIL APPEAL NO W-02–3099 OF 2010
MOHD HISHAMUDIN, AZIAH ALI AND MOHTARUDIN BAKI JJCA
11 MARCH 2014

*Patents — Novelty — Valid prior art — Elements of claim in patent found existing in prior art exhibit — Whether patent lacked novelty and invalid — Whether correct test to determine if patent was anticipated by prior art was to compare claims of patent against prior art and not by comparing physical product claiming patent protection against prior art exhibit — Whether concept used in patented invention obvious and common knowledge in field of mechanical engineering*

The respondent was the registered owner of a patent ('the patent') for an invention using interlocking scrolls and hinges and a 'tongue and groove' locking method in roller shutters and roller doors it produced mainly for use in business outlets and shops. In an action in the High Court, the respondent sued the first appellant and its director and shareholder, the second appellant, for infringing the patent by making, selling and using roller shutters and other related products incorporating the patent's features without the respondent's permission. The appellants contended that the patent was invalid because it lacked novelty and/or inventive step and that it had been anticipated by prior art and was in use before the patent was applied for. In support of its contention, the appellants relied on three pieces of prior art, one of which was a PVC aluminium piece ('the PVC piece') which had been sold in the market well before the date of application for the patent. In allowing the respondent's claim, the trial judge compared the PVC piece — which comprised of two physical parts — to the respondent's invention which comprised of three parts and found that a person would have had to be inventive and exploratory to first dismantle and then convert the PVC piece into a functional three-part product. The trial judge held that the invention in the patent was substantially different from the PVC piece as it involved an inventive step that was not obvious to a person skilled in the art. Consequently, the patent was held to be novel and not anticipated by the PVC piece and therefore valid and infringed by the appellants. In the instant appeal, the appellants argued that the trial judge erred in comparing the respondent's physical product with the PVC piece when the correct test should have been to compare the features of the patent's claims with the features of the PVC piece or prior art. It was also contended that the trial judge also took the wrong approach when assessing

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whether the patent was obvious and lacking in inventive step vis-a-vis the PVC piece/prior art.

**Held**, allowing the appeal and setting aside the decision of the High Court:

(1) In considering whether the patent had been anticipated by prior art, the correct approach which should have been taken by the trial judge was to compare the claims of the patent that defined the invention against the prior art/the PVC piece and not, as the trial judge had done, compared the respondent's product with the PVC piece (see paras 14–15).

(2) On examining the respondent's patent claim 1, which was the defining claim, against the PVC piece assisted by the diagrams/drawings produced, the court agreed that all the elements found in claim 1 were found in the PVC piece. The patent therefore lacked novelty as it had been anticipated by prior art/the PVC piece. The respondent's invention had not met the requirements of s 14 of the Patents Act 1983 to be patentable under s 11 of the same Act and was invalid (see paras 26–27).

(3) The evidence of the witnesses in the case showed that the concept of 'tongue and groove' and of interlocking scrolls and hinges in the respondent's patent was common knowledge in the field of mechanical engineering which would have been obvious to a normally skilled but unimaginative addressee in the art. Conceptually, there was no difference in the concept of 'tongue and groove' and inter-engaging curled scrolls found in the patented invention vis-a-vis prior art (see paras 31–32).

**[Bahasa Malaysia summary**

Responden adalah pemilik berdaftar paten ('paten') untuk rekaan menggunakan skrol dan engsel yang bercantum dan 'tongue and groove' cara mengunci *roller shutters* dan *roller doors* yang dihasilkan terutamanya untuk digunakan di kedai-kedai perniagaan. Dalam tindakan di Mahkamah Tinggi, responden menyaman perayu pertama serta pengarah dan pemegang sahamnya, perayu kedua, kerana melanggar peten tersebut dengan membuat, menjual dan menggunakan *roller shutters* dan produk lain yang berkaitan dengan memasukkan ciri-ciri paten tanpa kebenaran responden. Perayu-perayu berhujah bahawa paten adalah tidak sah kerana ia tidak mempunyai pembaharuan dan/atau langkah rekaan dan bahawa ia telah didahului oleh paten terdahulu dan telah digunakan sebelum paten dipohon. Dalam menyokong hujahannya, perayu-perayu bergantung ke atas tiga bahan paten terdahulu, salah satu daripadanya adalah bahan aluminium PVC ('bahan PVC') yang telah dijual di pasaran sebelum tarikh permohonan untuk paten. Dalam membenarkan tuntutan responden, hakim bicara membandingkan bahan PVC — yang mengandungi dua bahagian fizikal — kepada rekaan responden yang mengandungi tiga bahagian dan mendapati bahawa seseorang adalah berdaya mereka cipta dan memeriksa untuk membuka terlebih dahulu

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dan kemudiannya menukar bahan PVC kepada produk tiga bahagian yang berfungsi. Hakim bicara memutuskan bahawa rekaan paten tersebut adalah secara substansial berbeza daripada bahan PVC kerana ia melibatkan langkah reka cipta yang tidak jelas kepada seseorang yang pakar dalam seni. Akibatnya, paten tersebut diputuskan sebagai baharu dan tidak dikira sebagai bahan PVC tersebut dan oleh itu sah dan dilanggar oleh perayu-perayu. Dalam kes ini, perayu-perayu berhujah bahawa hakim bicara tersilap dalam membezakan produk fizikal responden dengan bahan PVC tersebut apabila ujian betul sepatutnya adalah untuk membandingkan ciri-ciri paten yang dituntut dengan ciri-ciri bahan PVC atau paten terdahulu. Ia juga dihujahkan bahawa hakim bicara juga mengambil pendekatan yang salah apabila menilai sama ada paten adalah jelas dan kekurangan dalam langkah reka cipta berkenaan bahan PVC/paten terdahulu.

**Diputuskan**, membenarkan rayuan dan mengetepikan keputusan Mahkamah Tinggi:

(1) Dalam mempertimbangkan sama ada paten telah didahului dengan paten terdahulu, pendekatan betul yang patut diambil oleh hakim bicara adalah untuk membandingkan tuntutan paten yang menentukan reka cipta terhadap paten terdahulu/bahan PVC dan bukan, seperti yang telah dilakukan oleh hakim bicara, membandingkan produk responden dengan bahan PVC tersebut (lihat perenggan 14–15).

(2) Dalam memeriksa tuntutan 1 paten responden, yang mana adalah tuntutan yang dimaksudkan, terhadap bahan PVC dibantu oleh gambar rajah/lukisan yang dikemukakan, mahkamah bersetuju bahawa kesemua elemen yang didapati di dalam tuntutan 1 didapati di dalam bahan PVC tersebut. Oleh itu paten tersebut tidak mempunyai pembaharuan memandangkan ia telah didahului oleh paten terdahulu/bahan PVC tersebut. Rekaan responden tidak memenuhi kehendak-kehendak s 14 Akta Paten 1983 untuk dipatenkan di bawah s 11 Akta yang sama dan adalah tak sah (lihat perenggan 26–27).

(3) Keterangan saksi-saksi dalam kes menunjukkan bahawa konsep 'tongue and groove' dan skrol dan engsel yang bercantum dalam paten responden adalah pengetahuan umum dalam bidang kejuruteraan mekanikal yang mana adalah jelas kepada orang yang mahir tetapi tidak berimaginasi dalam seni. Dari segi konsep, tidak ada perbezaan dalam konsep 'tongue and groove' dan 'inter-engaging curled scrolls' yang terdapat di dalam rekaan yang dipatenkan berkenaan seni terdahulu (lihat perenggan 31–32). ]

**Notes**

For a case on valid prior art, see 10 *Mallal's Digest* (4th Ed, 2013 Reissue) para 1247.

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**Cases referred to**

*Vickers, Sons & Co Ltd v Siddell* (1890) 15 App Cas 496, HL (refd)
*General Tire and Rubber Co v Firestone Tyre and Rubber Co Ltd* [1972] RPC 457, CA (folld)
*Technograph Printed Circuits Limited v Mills & Rockley (Electronics) Limited* [1972] RPC 346, HL (refd)
*Windsurfing International Inc v Tabur Marine (Great Britain) Ltd* [1985] RPC 59, CA (folld)

**Legislation referred to**

Patents Act 1983 ss 11, 12, 13 , 14 , 15, 16, 31(1), 56(2), 56(2)(a)

**Appeal from:** Suit No D-22IP-800 of 2008 (High Court, Kuala Lumpur)

*Ambiga Sreenevasan (Vanini Rajeswaran with her) (Ranjit Singh & Yeoh) for the appellants.*
*Eow Khean Fatt (Shen, Eow & Partners) for the respondent.*

**Aziah Ali JCA (delivering judgment of the court):**

**[1]** The appellants appeal against the decision of the High Court which allowed the respondent's claim against the appellants for infringement of Patent No MY-128431-A ('MY Patent') entitled 'Rolling Door' ('the plaintiff's patent'). For the purpose of this judgment the parties will be referred to as they were in the court below; that is to say, the appellants will be referred to as the 'defendants', whilst the respondent will be referred to as the 'plaintiff'.

BRIEF BACKGROUND FACTS

**[2]** The plaintiff, SKB Shutters Manufacturing Sdn Bhd is in the business of manufacturing, distributing and dealing in roller shutters, roller doors and a wide range of shutters. The plaintiff is the registered proprietor of the MY Patent. The plaintiff manufactures and distributes roller doors and roller shutters (exh P2) that incorporates the invention under the said MY Patent which are marketed and promoted under the name 'SKB VISION 7' (see pp 431–450 of the appeal record). The plaintiff is also the registered owner of Trade Mark Registration No 98009483 'SKB VISION 7' in Malaysia for goods and services in class 6.

**[3]** The first defendant, Seng Kong Shutter Industries Sdn Bhd is also in the business of dealing with roller shutters and other related products. The second defendant, Tan Kooi Lim is a director and shareholder of the first defendant.

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THE CLAIM

**[4]** The plaintiff's claim against the defendants is for patent infringement. The plaintiff alleges that while the plaintiff's patent is valid and subsisting, the defendants infringed the said patent by making, selling, offering to sell and using, without the consent or licence of the plaintiff, products that incorporated features of the said patent (exhs P3 and P5 at pp 451–456 of the appeal record).

THE DEFENCE

**[5]** By way of defence to the claim for patent infringement, the defendants challenged the validity of the plaintiff's patent. The defendants contended that the plaintiff's patent is neither novel nor new because the invention of the plaintiff's patent had been anticipated by the public availability in the market and prior disclosure and use of Prior Art at the point in time before the filing of the plaintiff's patent on 24 February 1997. In support of its contention, the defendants produced and relied on three pieces of prior art ('the prior art'), namely:

(a) PVC aluminium piece ('the PVC piece') marked as exhs D12 and D18 which had been sold in the market since 1996, which is prior to the date of application of the plaintiff's patent on 24 February 1997 (p 546 of the appeal record);

(b) United States Patent 5,456,305 ('US 305 Patent') marked as exh D25 which was filed on 18 January 1995 and published prior to 24 February 1997 (pp 527–532 of the appeal record); and

(c) United States Patent 4,433,714 ('US 714 Patent') marked as exh D26 which was filed on 23 October 1981 and published prior to 24 February 1997 (pp 533–540 of the appeal record).

**[6]** In the court below learned counsel for the defendants had submitted that the joining of the slat to the bracket using the male and female tongue method and the groove method and the pivotal hinging of panels using the interlocking scrolls are disclosed in the PVC piece. Thus it is the defendants' case that the plaintiff's patent is invalid by reason of lack of novelty and/or lack of inventive step and does not meet all the patentability requirements, particularly ss 11, 14 and 15 of the Patents Act 1983 ('the Act'). It is further contended that the object of the plaintiff's patent was to increase the level of transparency of the roller shutter and to prevent the entry of small animals, cold and wind and rain. However the claims in the plaintiff's patent do not appear to solve these problems. For these reasons it is submitted that the plaintiff's patent ought to be invalidated.

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A DECISION OF THE HIGH COURT

**[7]** In considering the defendants' contention that the plaintiff's patent ought to be invalidated by reason of lack of novelty, the learned judge referred to s 14 of the Act which states as follows:

B

> Novelty
>
> 14(1) An invention is new if it is not anticipated by prior art.
>
> (2) Prior art shall consist of —
>
> C
>
> (a) everything disclosed to the public, anywhere in the world, by written publication by oral disclosure, by use or in any other way, prior to the priority date of the patent application claiming the invention;
>
> (b) the contents of a domestic patent application having an earlier priority date than the patent application referred to in paragraph (a) to the extent that such contents are included in the patent granted on the basis of the said domestic patent application.
>
> D
>
> (3) A disclosure made under paragraph (2)(a) shall be disregarded —
>
> (a) if such disclosure occurred within one year preceding the date of the patent application and if such disclosure was by reason or in consequence of acts committed by the applicant or his predecessor in title;
>
> E
>
> (b) if such disclosure occurred within one year preceding the date of the patent application and if such disclosure was by reason or in consequence of any abuse of the rights of the applicant or his predecessor in title;
>
> F
>
> (c) if such disclosure is by way of a pending application to register the patent in the United Kingdom Patent Office as at the date of coming into force of this Act.
>
> (4) Subsection (2) shall not exclude the patentability of any substance or composition, comprised in the Prior Art, for use in a method referred to in paragraph 13(1)(d), if its use in any such method is not comprised in the Prior Art.
>
> G

**[8]** The learned judge acknowledged that s 14 requires an invention to be new ie it should not form part of the state of the art on the date of filing the patent application.

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**[9]** On the issue of whether the plaintiff's patent has been anticipated, His Lordship referred to the case of *General Tire and Rubber Co v Firestone Tyre and Rubber Co Ltd* [1972] RPC 457. In that case at the first instance, the attack on the patent concentrated on seeking to establish anticipation, obviousness and absence of any inventive step, and absence of sufficient and clear definition or ambiguity. The court was concerned with the issue of anticipation by prior publication, and according to the court, 'the question whether the patentee's claim is new ... falls to be decided as a question of fact' (p 485). In the judgment delivered by Sachs LJ, His Lordship said, inter alia, as follows (p 486):

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> If the prior inventor's publication contains a clear description of, or clear instructions to do or make, something that would infringe the patentee's claim if carried out after the grant of the patentee's patent, the patentee's claim will have been shown to lack the necessary novelty, that is to say, it will have been anticipated ...
>
> To anticipate the patentee's claim the prior publication must contain clear and unmistakable directions to do what the patentee claims to have invented: ...

**[10]** The learned judge found that the PVC piece does not contain clear and unmistakeable directions to do what the inventor claims to have invented in the plaintiff's patent. According to His Lordship the PVC piece comprises of two physical parts as opposed to the subject invention of the plaintiff's patent which comprises three parts. There are no clear teachings or instructions that would lead a person skilled in the art to remove the links from the PVC piece. The removal of the links in the PVC piece would render the product completely unusable unless significant alterations are further made to the product. There must be a significant amount of tampering with the PVC piece by cutting the links of the single piece aluminium frame and altering it in order for it to be viewed as a three-part product. Thus any person intending to do so would be venturing into an inventive and exploratory effort. Therefore the learned judge found that the subject invention of the plaintiff's patent is substantially different because the plaintiff's patent involves an inventive step that is not obvious to a person skilled in the art. Consequently the learned judge disagreed with learned counsel for the defendants that the plaintiff's patent is not novel and lacked inventive step. The learned judge found that the plaintiff's claimed invention is novel and the defendants have failed to establish that the plaintiff's patent has been anticipated by the PVC piece. The plaintiff's patent is therefore valid and the defendants have infringed the plaintiff's patent. Hence the learned judge allowed the plaintiff's claim of patent infringement.

THE APPEAL

**[11]** Before us it is submitted for the defendants that the accepted principle of law in assessing if a prior art in question anticipates the subject invention of a patent is by comparing the features of the claims of the patent with the features of the prior art (*General Tire and Rubber Co v Firestone Tyre and Rubber Co Ltd*). The correct test then is to compare the features of the plaintiff's patent claims with the features of the prior art/PVC piece and not by comparing the product that is manufactured in accordance with the patent with the prior art. It is submitted that in the instant case His Lordship has erred by comparing the plaintiff's product with the prior art and this is evident by the observations made by His Lordship in his grounds of judgment that the PVC piece comprises of two physical parts as opposed to the plaintiff's patent that has three parts.

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**[12]** Learned counsel further submits that the trial judge has erred by not applying the correct approach in assessing whether the plaintiff's patent is obvious as against the prior art/PVC piece to show lack of inventive step. Learned counsel cites the case of *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd* [1985] RPC 59 wherein Oliver LJ posed four questions as being the correct approach to be adopted for assessing non-obviousness. The approach to be adopted by the court is as follows:

(a) to identify the invention or concept in the patent suit;

(b) to assume the mantle of the normally skilled but unimaginative addressee in the art at the relevant date and to impute to him what was at that date, common general knowledge in the art in question;

(c) to identify what, if any, differences exist between the matters cited as being 'known or used' and the alleged invention; and

(d) the court has to decide whether, viewed without any knowledge of the alleged invention, those differences constitute steps which would have been obvious to the skilled man or whether they required any degree of invention.

It is submitted that had the learned judge adopted the correct approach and accepted the evidence of DW3, Yap Mew Sang who is a mechanical engineer and an independent witness and who is skilled in the art as opposed to the evidence of PW1 Sin Kheng Lee, who is the managing director of the plaintiff and is also the inventor of the plaintiff's patent, then it is clear that the plaintiff's patent is obvious and lacks inventive step.

**[13]** For the plaintiff, learned counsel concedes that the prior art/PVC piece has already existed at the time of the filing of the plaintiff's patent but submits that the correct test is to compare the plaintiff's product with the prior art. Learned counsel submits that the learned judge has correctly applied the approach as laid down in *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd* and has correctly rejected the evidence of DW3. It is submitted that the defendants have failed to show that the prior art has the same features as the plaintiff's product as the panels in the plaintiff's product do not interlock in the same way as the PVC piece.

**[14]** With respect, we are unable to agree with learned counsel for the plaintiff that the learned judge has applied the correct test in considering the issues of novelty and anticipation. We agree with learned counsel for the defendants that, in considering the issue of whether the plaintiff's patent has been anticipated by prior art, the correct approach to be adopted is to compare the claims of the plaintiff's Patent that defines the invention against the prior art/PVC piece. In *General Tire & Rubber Co* cited by learned counsel for the defendants, Sachs LJ in his judgment at p 485 said, inter alia, as follows:

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> ... To determine whether a patentee's claim has been anticipated by an earlier publication it is necessary to *compare the earlier publication with the patentee's claim* ... If the earlier publication, so construed, discloses the same device as the device which the patentee by his claim, so construed, asserts that he has invented, the patentee's claim has been anticipated, but not otherwise. In such circumstances the patentee is not the true and first inventor of the device and his claimed invention is not new ... (Emphasis added.)

**[15]** We have perused the grounds of judgment of the trial judge and with respect, we find that in arriving at his finding that the defendants have failed to establish that the plaintiff's patent has not been anticipated by the PVC piece, the learned judge has not referred to the plaintiff's patent claims and compare it to the prior art. Instead, as rightly submitted by learned counsel for the defendants, the learned judge had compared the plaintiff's product with the PVC piece. On this ground we agree with the defendants' contention that the learned judge has not applied the correct approach as laid down in the case of *General Tire & Rubber Co*.

**[16]** Section 56(2)(a) of the Act states that the court shall invalidate the patent if the person requesting the invalidation proves that what is claimed as an invention in the patent:

(a) is not an invention within the meaning of s 12; or

(b) is excluded from protection under s 13 or sub-s 31(1); or

(c) is not patentable because it does not comply with the requirements of s 11, 14, 15 and 16.

NOVELTY AND ANTICIPATION

**[17]** Newness is a requisite for patentability and it must be novel. Therefore to secure a patent, novelty is a fundamental requirement (see ss 11 and 14 of the Act).

**[18]** Novelty is not something which can be proved or established, only its absence can be proved or established. The determination of novelty of an invention strictly consists of consideration of two aspects — the invention claimed for protection and the prior art information available in the concerned field. The knowledge of an invention in order to be considered as relevant prior art should satisfy any one or more of the following:

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(a) by the description of the invention in a published writing or document or in any tangible form;

(b) by description of the invention in spoken words uttered in public, such a disclosure is known as oral disclosure; and

(c) by the use of the invention in public or by putting the public in a position where any member of the public may access to it.

The test for establishing the lack of novelty is that each and every ingredient element of the claimed invention must be present in a single prior art (see *Subbaram on Patent Law, Practices & Procedures* (2nd Ed)).

**[19]** Proof that an invention is not new and lacks novelty because it has been anticipated by prior art constitutes a ground for the invalidation of such invention (s 56(2) of the Act). The onus of proof lies, as regards each allegation, on the party launching the attack (*General Tire and Rubber Co*).

**[20]** Reverting to the instant case, it is therefore necessary to examine the plaintiff's patent claims (pp 379–398 of the appeal record) vis-a-vis the PVC piece in order to determine whether the defendant has established that the PVC piece anticipates the subject invention of the plaintiff's patent and thus the plaintiff's patent lacks novelty.

**[21]** There are 11 claims in the plaintiff's patent application (pp 390–393 of the appeal record), however, learned counsel for the defendants, Dato' Ambiga, submits that the court need only to consider claim 1 which describes the basic invention, and claims 9 and 11. The other claims are, what learned counsel describes as, 'dependent claims'. For the purpose of demonstrating that the plaintiff's patent as described in claim 1 is not new and is anticipated by prior art and/or lacks novelty, the defendants produced before us the plaintiff's product (marked as 'MY Patent') and the PVC piece (exh D12). The defendants have also produced diagrams/drawings to further assist the court to appreciate the features stated in claim 1 which the defendants claim are also found in the PVC piece in order to show that the plaintiff's patent has been anticipated by prior art, is not novel, is obvious and lacks inventive step.

**[22]** As proposed by learned counsel for the defendants, we assessed the plaintiff's patent claim 1 to determine whether the defendant has established that the PVC piece anticipates the plaintiff's patent and therefore the plaintiff's patent lacks novelty.

**[23]** We take the liberty of reproducing below the plaintiff's claim 1 as summarised by learned counsel for the plaintiff at the High Court and reproduced in the learned judge's grounds of judgment, and the

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diagrams/drawings that were submitted to us during the appeal as follows: A

Claim 1 — is essentially a panel suitable for use in a rolling door of the type, including a door curtain supported on a roller assembly for movement between open and closed position; comprising:

(i) an elongated body member [21] (hereinafter the 'Slat') having a first longitudinal edge [53] (hereinafter the 'First Edge') and a second longitudinal edge [54] (hereinafter the 'Second Edge'); B

(ii) the first engagement means (hereinafter the 'First Bracket') is positioned on the said First Edge and second engagement means (hereinafter the 'Second Bracket') positioned on the said Second Edge, each arranged so as to engage complementary engagement means (hereinafter 'Brackets') on an adjacent edge of another panel to link the panels and thereby form the said curtain door; C

(iii) the First and Second Brackets each comprises a bracket member [27,28] mounted on the First Edge or said Second Edge, as appropriate, and extending substantially along its length; and a flange [49,52] (hereinafter the 'Flange') extending from the said bracket member substantially transversely to the said First Edge or said Second Edge, said Flange comprising a link portion [45,46] and an engagement portion [47,48] (hereinafter the 'Interlocking Scrolf'), wherein the said Interlocking Scroll has a curved cross-section with a curvature suitable to engage the Interlocking Scroll of a Flange extending from a bracket member mounted on an adjacent edge of another panel; D E

(iv) the said bracket member has a base [31,34], a first arm [29,33] and a second arm [30,32], each arm extending substantially transversely from the said base so that the said bracket member [27,28] is substantially U-shaped in cross-section. F

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A

B

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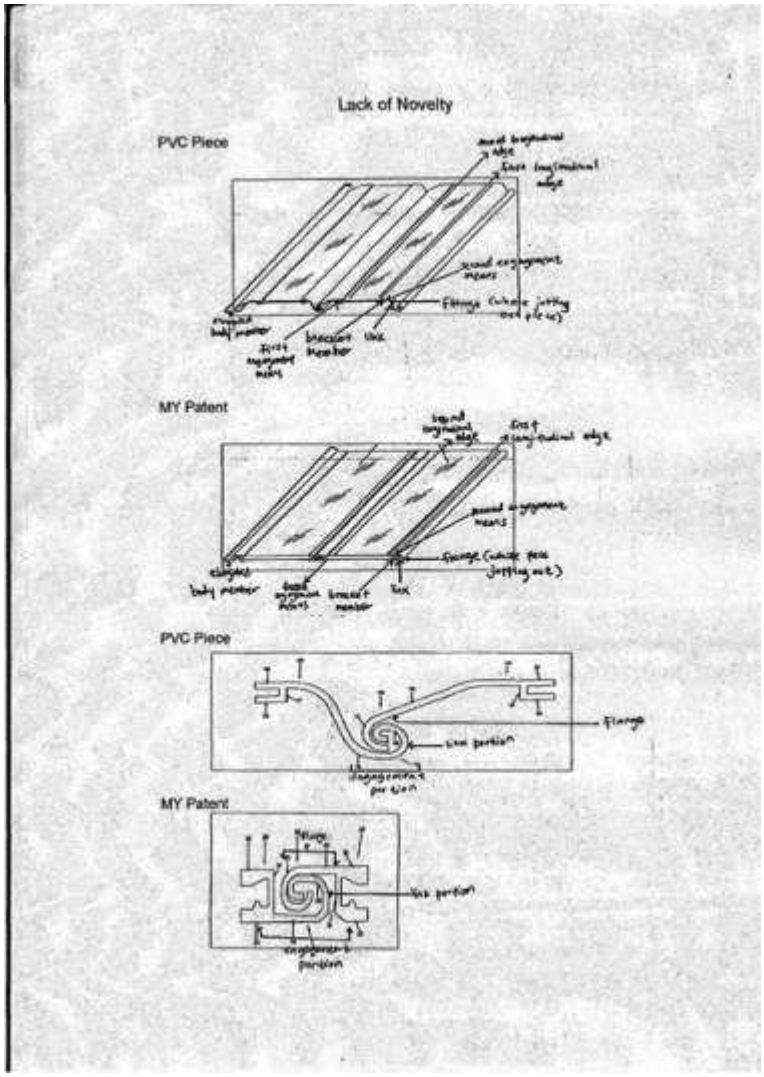

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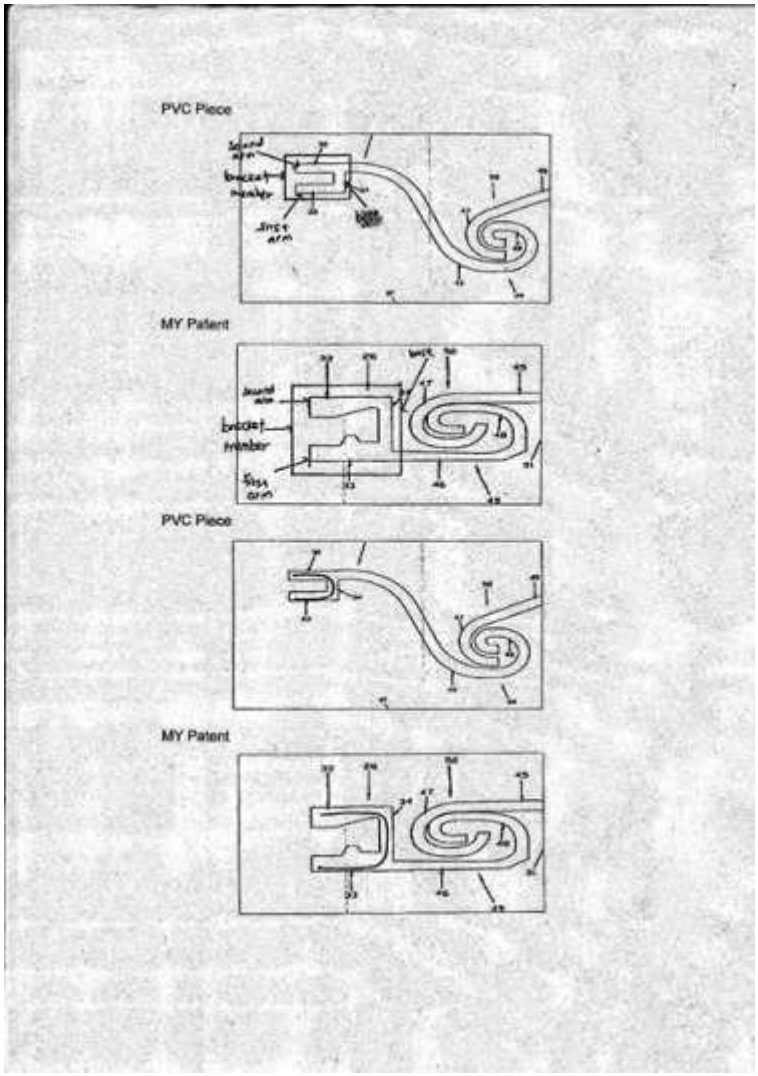


**[24]** Learned counsel for the defendants submits that a comparison of the elements in claim 1 as against the PVC piece shows that the elements in claim 1(i)–(iv) are all found in the PVC piece. In respect of claim 9 it is submitted that this claim is inherently defective because it refers to itself. Claim 9 reads as follows:

> 9. A panel as claimed in claim 9 wherein the said plastics material is transparent.

With respect to claim 11 which states:

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A

> 11. A panel suitable for use in a rolling door (50) of the type including a door curtain (51) supported on a roller assembly (50) for movement between open and closed positions; comprising an elongated body member (21) having a first longitudinal (53) and a second longitudinal edge (54);

B it is submitted that the plaintiff's own expert witness PW2, Jeremy John Day who is a patent attorney, concedes that the prior art US Patent 305 is probably destructive of the novelty of claim 11 (p 301 of the appeal record).

C **[25]** We have perused the plaintiff's patent application (pp 380–381 of the appeal record) in which it is stated that the object of the plaintiff's invention is to essentially resolve a problem found in existing roller doors that are used to secure businesses and shops. It was found that conventional roller doors are made of steel or aluminium which prevent potential customers from viewing the goods in the shop when the shop is closed. One approach is to use a roller door of extruded aluminium tubes arranged to form a grid to prevent intruders from gaining access into the businesses or shops but such door does not prevent the penetration of small animals which may damage the contents of the business or shop. Cold wind and rain may also cause damage to the stock in the businesses and shops. The plaintiff's invention recognises that it would be desirable to have a rolling door wherein the door curtain is formed of a transparent material and then provide an arrangement which allows such a door to be assembled.

F **[26]** As we have observed earlier, and as found by the learned judge, the PVC piece does not contain clear and unmistakable directions to do what the inventor claims to have invented. What is available is the PVC piece itself. Adopting the approach as laid down in the *General Tire & Rubber Co* we have assessed the plaintiff's patent claim 1 which is the defining claim against the PVC piece assisted by the diagrams/drawings produced. Having done so and having given considerable thought to what is before us, we agree with learned counsel for the defendants that all the elements found in the plaintiff's patent claim 1 are found in the PVC piece.

H **[27]** We agree with the defendants that the plaintiff's patent lacks novelty as it has been anticipated by the prior art/PVC piece. We find that the plaintiff's invention has not met the requirements of s 14 of the Act to be patentable under s 11 of the same Act. The plaintiff's patent is thereby invalid.

I **[28]** Having made our finding that the plaintiff's patent is invalid for lack of novelty, we are of the view that there is no necessity to proceed with the determination of whether the plaintiff's patent is obvious. However for the purpose of completeness we would venture to state that obviousness would cover practically every case of lack of novelty (*Technograph Printed Circuits*

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*Limited v Mills & Rockley (Electronics) Limited* [1972] RPC 346). If any embodiment within the scope of the claim is obvious, then the claim is invalid (*Terrell on The Law of Patents* (15th Ed)). In *Vickers, Sons & Co Ltd v Siddell* (1890) 15 App Cas 496, Lord Herschell pointed out that obviousness connotes something which would at once occur to a person skilled in the art who was desirous of accomplishing the end.

OBVIOUSNESS

**[29]** In considering whether the invention claimed is obvious and hence did not involve any inventive step to devise a product or process falling within the scope of the claim, the relevant comparison is not between the preferred embodiment of the invention claimed and the prior art. Rather the question to be asked is 'to whom must the invention be obvious?'. As to this question Lord Reid in *Technograph Printed Circuits Limited v Mills & Rockley (Electronics) Limited* said as follows (p 355):

> It is not disputed that the hypothetical addressee is a skilled technician who is well acquainted with the workshop technique and who has carefully read the relevant literature ... When dealing with obviousness, unlike novelty, it is permissible to make a 'mosaic' out of the relevant documents, but it must be a mosaic which can be put together by an *unimaginative man with no inventive capacity*.
>
> Whether or not it was obvious to take a particular step is a question of fact ... But the question is not whether it is now obvious to the court but *whether at the relevant date it would have been obvious to the unimaginative skilled technician.* A thing which may now seems obvious to anyone may at that date have been far from obvious to him. (Emphasis added.)
>
> On this matter the evidence of experts is generally valuable and often necessary. Then, as in all matters where expert evidence is relevant, the court must weigh the expert evidence.

**[30]** The primary evidence is therefore that of an expert, who can give evidence as to the nature of the unimaginative skilled addressee, the body of knowledge (the so-called common general knowledge) which he would possess and the way in which such a skilled man would, as a matter of routine, approach problems. He can also identify steps which he believes would require a degree of lateral thinking and hence not be obvious to the skilled man. (*Terrell on The Law of Patents* (15th Ed)).

**[31]** We have considered the testimonies of PW1 who is the inventor of the subject of the patent and DW3 who is an engineer, an inventor and product and process designer. He is also an Exco member of the Malaysian Invention and Design Society. We are of the view that both PW1 and DW3 can hardly be described as 'the unimaginative skilled addressee'. However what can be gleaned from the evidence of PW1 is that the tongue and groove concept which

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is a method of joining two pieces of material together is a known concept in mechanical engineering. According to him through a lot of research and development he finally arrived at the particular shape for the tongue and groove for the plaintiff's patent which he says is different from other roller shutters. Thus on his evidence the invention or concept in his product is the shape of the tongue and groove. DW3 in his evidence confirmed that the plaintiff's patent employed the tongue and groove method which are elementary engineering concepts. Similarly with the concept of the interlocking scrolls and hinges. PW2 Jeremy John Day, in his answer to question no 9 of his witness statement (p 293 of the appeal record) states that 'Conventionally, the panels of roller shutter doors are hingedly connected together by inter-connecting scrolls along their edges'. In cross-examination PW2 agreed that the inter-engaging curled scrolls exists in prior art and that the male and female tongue and the groove joining method are common general knowledge. In re-examination PW2 again agreed that the tongue and groove method of joining two materials is common general knowledge in the field of mechanical engineering.

**[32]** Guided by the approach to be adopted for assessing non-obviousness as laid down in *Windsurfing International Inc v Tabur Marine (Great Britain) Ltd* we find from the evidence that the concept in the plaintiff's patent is common general knowledge in the field of mechanical engineering which would be obvious to a normally skilled but unimaginative addressee in the art. Conceptually we find no difference between the concept of tongue and groove method and inter-engaging curled scrolls found in the subject invention of the plaintiff's patent and the prior art.

**[33]** In *Terrell on The Law of Patents* (15th Ed), it is stated at p 199 as follows:

> It has been said that there cannot in any event be an infringement of an invalid patent. Thus Jacob J said in *Organon Teknika v Hoffman-La Roche* [1996] FSR 383 at 386: 'in English law validity and infringement are part of the same questions. You cannot infringe an invalid claim, even if you fall within its language'.

We respectfully adopt the same. We find that the plaintiff's claim against the defendants for patent infringement has not been established. For the reasons stated we allow the appeal and set aside the judgment of the High Court in respect of the claim for patent infringement. We award costs of the appeal to the appellant as agreed in the sum of RM25,000. In respect of costs at the High Court we award the sum of RM50,000. The deposit is refunded.

*Appeal allowed and decision of the High Court set aside.*

Reported by Ashok Kumar